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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,889	09/16/2003	Kerry Stephen McClure	27735-11	4514
24256	7590	12/15/2005	EXAMINER	
DINSMORE & SHOHL, LLP 1900 CHEMED CENTER 255 EAST FIFTH STREET CINCINNATI, OH 45202			LARSON, JUSTIN MATTHEW	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,889

Applicant(s)

MCCLURE ET AL.

Examiner

Justin M. Larson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8 and 11-26 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 7, 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/24/04, 8/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 5/24/04 and 8/24/04 are noted. The submissions are in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 120. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

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As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

4. The disclosure is objected to because of the following informalities:

Sections/headings are underlined and/or in bold. Please note, "Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading." Appropriate correction is required.

5. Also, the abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 3, 11, 14, 15, 16, 21, 22, 23, 24, and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/894,488. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both encompass the same invention.

All of the limitations of applicant's above-mentioned claims are recited in the '488 application except for the support structure being attached to a vehicle, namely a pickup truck, and the shell (referred to as a 'chamber' in the '488 application) including first and second end portions, having a side portion extending between the end portions, partially

defining a spare tire storage chamber, having an opening adjacent the first end portion, and having an arcuate configuration.

Regarding the vehicle limitation, it would clearly have been obvious to attach the support structure to a any commonly driven vehicle, including pickup trucks, because the support structure would be of no use to the vehicle's operator if the spare tire was not in fact attached to the vehicle in a time of need.

Regarding the structural limitations of the chamber, Examiner referred to the disclosure of the '488 application to determine what was meant by the term 'chamber' in order to understand the complete metes and bounds of the claims. In light of the disclosure, the claimed chamber clearly has a first and second end, a side portion extending between the end portions, partially defines a spare tire storage chamber, includes an opening adjacent to the first end portion, and has an arcuate configuration.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 13 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/894,488 in view of Teson (5,222,640). Although it would have been obvious to attach the support structure to a vehicle such as a pickup truck, the claims of the '488 application do not render it obvious to necessarily include the support structure in the bed of a pickup truck as opposed to another location of the pickup truck, perhaps the floor of the cab if there was enough space. Teson, however, teaches that it is known to store a spare tire in the bed of a pickup truck and therefore, it

would have been obvious to one having ordinary skill in the art to implement the present invention in the bed of a pickup truck in order to hide the spare tire under the floor of the bed, unlike the Teson invention, which leaves the spare tire to occupy storage space within the bed of the pickup truck.

This is a provisional obviousness-type double patenting rejection.

9. Claims 17, 18, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/894,488 in view of Wilson (4,230,246). The '488 application discloses a sliding tray member which slides within a shell from a stored position to an extended position.

Wilson also discloses such a sliding system and teaches that the sliding tray member can be slid outward from its stored position with the shell into its extended position and that the tray can be secured in this extended position by placing a locking flange (17/71) into a recess region (73) formed in the shell (Figures 4 and 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the sliding system of the '488 application by using a locking flange and recess configuration, as taught by Wilson, in order to secure the sliding tray in its extended position.

10. Regarding claim 19, Application '488 in view of Wilson fails to disclose multiple recesses formed in the shell. Examiner takes the position that it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement more than one flange/recess locking configuration into the structure of

Application '488 in view of Wilson, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The idea of using such a flange/recess locking configuration has already been clearly taught by Wilson and implementing multiple flange/recess configurations produces no new or unexpected result, as it still goes to hold the tray/support member in its extended position, just as one flange/recess configuration did.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 3, 6, 8, 11, 14, 15, 16, 20, 21, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukushima et al. (2001/0052712). Regarding claim 1, Fukushima et al. discloses a vehicle having a support structure comprising: a shell (14, Figure 3) attached to the vehicle, the shell including first and second end portions and a bottom portion extending at least partially between the first and second end portions (Figure 6), the shell at least partially defining a storage chamber and including an opening providing access to the storage chamber, the opening being adjacent to the first end portion (Figure 6); a support member (1), the support member

being slidably positioned above the bottom portion and movable back and forth along a movement path from a first position (Figure 1) in which the support member is substantially disposed within the shell and a second position (Figure 2) in which the support member is at least partially disposed outside the shell, the support member including a lower interface surface for directly contacting an upper interface surface (17) of the bottom portion of the shell in sliding engagement as the support member is moved along the movement path (col. 5 lines 50-53); and a retention member (26 or 15) fixedly attached to the shell, the retention member permitting sliding movement of the support member along the movement path with respect to the shell, and being operative to limit movement of the support member with respect to the shell in at least one direction substantially perpendicular to the movement path.

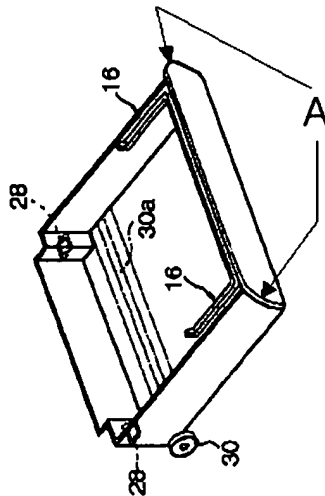
Regarding the system being used to support a spare tire, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Fukushima et al. which is capable of being used in the intended manner, i.e., to hold a spare tire in a sliding vehicle compartment. There is no structure in Fukushima et al. that would prohibit such functional intended use (see MPEP 2111).

13. Regarding claim 3, Fukushima et al. discloses stoppers (15) configured to engage the support member, the stoppers being disposed adjacent to the second end portion of the support member, effectively satisfying the limitations of the claim.

14. Regarding claim 6, Fukushima et al. discloses an outer edge on the support member, the outer edge extending outwardly and generally perpendicularly from the

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movement path. The outer edge (A) is shown in the figure below, taken from Fukushima et al., Figure 6.



15. Regarding claims 8 and 11, the retention members (two each of 15 or 26) of Fukushima et al. are in fact components of, or constituents of, the shell. Therefore Examiner considers these retention members to satisfy at least on definition of being integral with the shell, effectively satisfying the limitations of the claim.

16. Regarding claim 14, the shell of Fukushima et al. clearly has two side walls, or side portions, extending between the front and back walls, or the first and second end portions of the shell, effectively satisfying the limitations of the claim.

17. Regarding claims 15, 16, 21, and 26, Fukushima et al. discloses a locking configuration (26/28) for substantially inhibiting sliding movement of the support member relative to the shell along the movement path when the support member is selectively positioned relative to the shell (col. 6 lines 65+). In order to function properly, the locking member (26) on the shell must be aligned with the mating locking member

(28) on the support member, effectively acting as a complementary geometry, and satisfying the limitations of the claim.

18. Regarding claim 20, the cooperative locking configuration (26/28) of Fukushima et al. comprises a edge (28) protruding from support member (1) (Figure 8), the protruding edge effectively holding the support member in place when locked with member (26), satisfying at least one definition of the word "flange." Therefore, Examiner considers the limitations of the claim to be satisfied.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 12, 13, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. in view of Kennedy (4,676,415). Fukushima et al. discloses the claimed invention except for the aligned arrangement including apertures adapted to receive a locking member to inhibit sliding movement of the support member relative to the shell and the locking member comprising at least one of a pin and a rod.

Kennedy, however, discloses a spare tire support system which includes a spare tire support member adapted to slide between two positions in the trunk of a car. Kennedy teaches that the spare tire support member can be locked in place and thus prevented from sliding using a locking pin (92) through apertures in both the spare tire support member and the shell in which it slides (Figure 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the support structure of Fukushima et al. by either replacing the locking configuration (26/28) with an art equivalent locking configuration, or simply adding another locking configuration in addition to the already existing locking configuration, the new locking configuration involving a locking pin and apertures, as taught by Kennedy, in order to prevent the support member from sliding within the shell.

21. Regarding claims 12, 13, 24 and 25, Fukushima et al. fails to disclose the vehicle being a pickup truck and the support structure being attached to a bed of a pickup truck. Kennedy, however, teaches that it is already known in the art to attach sliding storage compartments to the beds of pickup trucks (Figures 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was that the support structure of Fukushima et al. could be implemented in any number of vehicles, including being attached underneath the beds of pickup trucks, as taught by Kennedy, in order to store a spare tire in the vehicle for use by the vehicle operator in case of an emergency.

Allowable Subject Matter

22. Claims 4, 5, 7, 9, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art relates to similar spare-tire carriers/storage assemblies.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on M-Th 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML
12/5/05


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER